PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Firmin GARCIA, et al.

Appln. No.: 10/525,224

Confirmation No.: 5613

Filed: February 22, 2005

Docket No: Q86091

Group Art Unit: 3754

Examiner: Lien M. NGO

For: FLUID PRODUCT DISPENSING ELEMENT AND DISPENSER COMPRISING ONE SUCH ELEMENT

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is VALOIS S.A.S. (assignee), of France, by virtue of an assignment executed by Firmin GARCIA and Stephane BERANGER (inventors), both of France, on January 13, 2005. The assignment was previously submitted and was recorded on February 22, 2005, at Reel 016929, Frame 0139.

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellant, the Assignee, and the Appellant's legal representative, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1, 2, 4-10, and 14-23 are pending in the present application and are all rejected. Claims 3 and 11-13 have been canceled. The rejections are summarized as follows:

Claims 1, 2, 4-8, and 14-19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knickerbocker (US 4,252,507); and

Claims 1, 2, 9, 10 and 20-23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garcia et al. (US 6,398,079) in view of Knickerbocker (US 4,252,507).

All of the claims pending in the appeal are set forth in their entirety in the Claims Appendix, attached to this Brief on Appeal.

IV. STATUS OF AMENDMENTS

A Final Rejection was mailed on September 10, 2008. Appellant submitted a Response under 37 C.F.R. § 1.116 on December 10, 2008, which requested reconsideration of the Final Rejection, but did not amend any claims. Thus, no Amendments have been submitted after the Final Rejection. In the Advisory Action dated December 18, 2008, the Examiner retained the rejections of the Final Rejection of September 10, 2008.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention of independent claims 1 and 2, the only independent claims pending in the application, concern a fluid dispenser comprising a fluid dispenser member for mounting on an opening (90) of a fluid reservoir (9), as illustrated in figures 1-3. (*See also* page 1, lines 3-5.)

Regarding independent claim 1, the fluid dispenser member comprises a body (1) inwardly defining a chamber (15) of variable volume, where the body defines a bottom end (10) of the fluid dispenser. (Page 5, lines 1-5; Fig. 1.) The fluid dispenser further comprises an actuator rod (7) that can be reciprocated axially in the body, thereby causing the volume in the chamber to vary. (Page 5, lines 6-24.) The rod comprises a bottom portion engaged in the body, and a top portion defining a top end (79). (Page 5, lines 17-21.) The fluid dispenser further comprises a peripheral bearing collar (52) extending radially outwards, said collar including a bottom face (51) designed to come into abutment, at least indirectly, against an edge (911) of the opening (90) of the fluid reservoir. (Page 5, lines 29-37.) The fluid dispenser is further defined by the axial height HS1 (*see* FIG. 1.) between the bottom face of the collar and the top end of the actuator rod being substantially equal to the axial height HIl (*see* FIG. 1) between the bottom face of the collar and the bottom end of the body. (Page 7, lines 8-13.) The heights of HS1 and HI1 are about 7 mm to 9 mm. (Page 7, lines 34-35.) Furthermore, the reservoir (9) includes a substantially cylindrical projecting neck (91) defining the opening (90) with a free top end forming an annular edge (911) on which the collar (52) rests and a bottom end connected to the reservoir body. (Page 5, line 33 to page 6, line 8.) The bottom end (10) of the body is situated in the neck. (Page 8, lines 3-6; *see also* FIGS. 2, 3.) The axial height HC of the neck is about 7 mm

to 9 mm with an inside diameter of about 8 mm and an outside diameter of about 13 mm. (Page 8, lines 12-15.)

Independent claim 2 differs from independent claim 1 in that, for example, it provides that the fluid dispenser member comprises a neck gasket (2) including a top face (21) and a bottom face (22), where the top face (21) contacts the bottom face (51) of the collar (52), and the bottom face (22) contacts an edge (911) of the opening (90) of the reservoir (9). (Page 5, line 33 to page 6, line 2.) The axial height HS2 (*see* FIG. 1) between the bottom face of the gasket and the top end of the actuator rod is substantially equal to the axial height HI2 (*see* FIG. 1) between the bottom face of the gasket and the bottom end of the body. (Page 7, lines 13-19.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are summarized as follows:

1. Whether claims 1, 2, 4-8 and 14-19 are properly rejected under 35 U.S.C. § 102(a) as being unpatentable over Knickerbocker (4,252,507).

2. Whether 1, 2, 9, 10 and 20-23 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Garcia et al. (6,398,079) in view of Knickerbocker (4,252,507).

VII. ARGUMENT

I. Claims 1, 2, 4-8 and 14-19 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Knickerbocker (4,252,507).

In rejecting claims 1, 2, 4-8 and 14-19 over Knickerbocker, the grounds of rejection state:

> Knickerbocker discloses, in figs. 1, a fluid dispenser comprising a fluid reservoir and dispenser member comprising a body 59 defining a chamber; an actuator rod 22; a peripheral bearing collar including a gasket (G) coming into abutment at least indirectly against an edge of an opening of the fluid reservoir; wherein the axial height between the bottom face of the collar and the top end of the actuator rod is substantially equal to the axial height between the bottom face of the collar and the bottom of the body and substantially equal to the axial height of a neck of the reservoir; a dispensing head 16 mounted on top of the rod.
>
> It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the height and diameter of claimed components of the fluid dispenser of Knickerbocker as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or values involves only routine skill in the art. In re Aller, 105 USPQ 233.

(Final Office Action, dated Sept. 10, 2008, page 2.)

Claims 1 & 2

Applicant responds that the Examiner improperly relies on the drawings of Knickerbocker as disclosing "wherein the axial height HS1 between the bottom face of the collar and the top end of the actuator rod is substantially equal to the axial height HIl between the bottom face of the collar and the bottom end of the body" and "wherein HS1 and HI1 are all about 7 mm to 9 mm" and "wherein the axial height HC of the neck is about 7 mm to 9 mm." It is well established that "arguments based on drawings not ***explicitly*** drawn to scale in issued

patents are unavailing." *Nystrom v. Trex Co.*, 424 F.3d 1136, 1149 (Fed. Cir. 2005) (emphasis added). Further, "[a]bsent any written description in the specification of quantitive values, arguments based on measurement of a drawing are of little value." *In re Wright*, 569 F.2d 1124, 1127 (C.C.P.A. 1977). Knickerbocker does not indicate that Figure 1 is made to scale nor does it describe any quantification of the dimensions of the device in the specification. Thus, Knickerbocker cannot properly be considered as disclosing the claimed dimensions or the relationships between the dimensions as recited in independent claims 1 and 2.

Even if, for the sake of argument alone, one were to measure Figure 1 of Knickerbocker, Knickerbocker still does not disclose the relationships between the recited dimensions in claims 1 and 2. As shown in the annotated Figure 1 of Knickerbocker, reproduced with annotations in an attached Appendix, the dimensions of Figure 1 disclose that: HS1 = 4.1 cm; and HI1 = 7.3 cm. Thus, in Knickerbocker HS1 $\neq$ HI1. As such, even if one improperly relies on the patent figures as does the Examiner in the grounds of rejection, Knickerbocker does not disclose the features of claims 1 and 2. To the contrary, it teaches away from the claimed subject matter.

Additionally, claims 1 and 2 indicate that the height of the neck HC ("about 7 mm to 9 mm") is approximately equal to the inside diameter of the neck Di ("8 mm") and that the outer diameter of the neck Do ("about 13 mm") is greater than the height of the neck HC ("about 7 mm to 9 mm"). Stated in other terms, claims 1 and 2 recite that Do > HC and HC $\approx$ Di. Knickerbocker does not disclose such relationships between the dimensions. As apparent from the annotated Figure 1 of Knickerbocker, even if one were to improperly rely on the patent figures as does the Examiner, Figure 1 of Knickerbocker discloses that: HC = 5.5 cm; Di = 3.1

cm; and Do = 4.8 cm. Thus, if the figures had been disclosed as being to scale, Knickerbocker discloses that HC > Do > Di. In view of the above, Applicants respectfully submit that Knickerbocker does not disclose the claimed relationships between the dimensions HS1, HI1, HC, Do, and Di.

The Examiner further alleges that it would have been obvious through routine experimentation to achieve the recited height and diameter of the components in claims 1 and 2. However, "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." MPEP § 2144.05(II)(B) (citing *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)). Nothing in Knickerbocker indicates that the relationship between the claimed dimensions is result-effective. Knickerbocker does not mention the claimed dimensions, let alone the relationship between the dimensions. In fact, Knickerbocker does not disclose any dimensions for any aspect of the device. As such, Knickerbocker has not established that the relationship between the claimed dimensions is result-effective and the relationship between the claimed dimensions would not have been achieved through routine experimentation. There is simply no rationale for why one skilled in the art would have modified the dimensions of the device in Knickerbocker to produce the claimed relationships in claims 1 and 2. *See KSR Int'l Co. v. Teleflex Inc.*, 82 UPQ2d 1385, 1396 (US 2007).

Dependent Claims

Applicants submit that dependent claims 4-8 and 14-19 are allowable at least by virtue of their respective dependencies from independent claims 1 or 2.

II. Claims 1, 2, 9, 10 and 20-23 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Garcia et al. (6,398,079) in view of Knickerbocker (4,252,507).

In rejecting claims 1, 2, 9, 10 and 20-23 over Garcia in view of Knickerbocker, the grounds of rejection state:

> Garcia et al. disclose, in fig. 1, a fluid dispenser comprising a fluid reservoir and dispenser member comprising a body 14 defining a chamber; an actuator rod 46; a peripheral bearing collar 511 including a gasket coming into abutment at least indirectly against an edge of an opening of the fluid reservoir; wherein the axial height between the bottom face of the collar and the top end of the actuator rod is substantially equal to the axial height between the bottom face of the collar and the bottom of the body; a dispensing head 4 mounted on top of the rod; a cover hoop 5; and a piston 48 sliding in a top section disposed entirely outside of the neck of the reservoir.
>
> *Garcia does not disclose the neck of the reservoir having an axial height being equal to the axial height between the bottom face of the collar and the top end of the actuator rod, and the axial height between the bottom face of the collar and the bottom of the body.*
>
> Knickerbocker teaches disclose a neck of a reservoir having an axial height being equal to the axial height between a bottom face of a collar and a top end of the actuator rod, and a axial height between the bottom face of the collar and the bottom of the body.

(Final Office Action, dated Sept. 10, 2008, at page 3.)

Claims 1 & 2

Regarding claims 1 and 2, Garcia does not disclose at least "wherein the axial height HS1 between the bottom face of the collar and the top end of the actuator rod is substantially equal to

the axial height HI1 between the bottom face of the collar and the bottom end of the body." The Examiner alleges that Figure 1 of Garcia discloses a fluid dispenser where HS1 approximately equals HI1. Once again, Garcia does not indicate that Figure 1 is made to scale nor does it describe any quantification of the dimensions of the device in the specification. Therefore, Garcia also cannot be properly considered as disclosing the relationships between the claimed dimensions.

Again, even if one were to improperly rely on the drawings of Garcia, Garcia does not even show the claimed relationship "wherein the axial height HS1 between the bottom face of the collar and the top end of the actuator rod is substantially equal to the axial height HI1 between the bottom face of the collar and the bottom end of the body." To the contrary, these dimensions in Garcia are shown as being substantially different.

Further, the Examiner acknowledges that Garcia does not disclose "an axial height [of the neck HC] being equal to the axial height between the bottom face of the collar and the top end of the actuator rod [HS1]. . ." The Examiner relies on Knickerbocker as disclosing such features. As discussed above, however, Knickerbocker does not disclose HC as being equal to HS1. Again, referring to the annotated Figure of Knickerbocker, HC $\neq$ HS1. Nor would it have been obvious through routine experimentation to create the claimed relationship between the dimensions because the relationships have not been identified as result-effective variables, nor has any further rationale been provided to render independent claims 1 and 2 obvious.

Dependent Claims

Dependent claims 9, 10 and 20-23 are allowable at least by virtue of their respective dependencies from independent claims 1 or 2.

III. Conclusion

The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Raja Saliba

Raja N. Saliba
Registration No. 43,078

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: May 11, 2009

CLAIMS APPENDIX

CLAIMS 1, 2, 4-10, and 14-23 ON APPEAL:

LISTING OF CLAIMS:

1. A fluid dispenser comprising both a fluid reservoir defining a reservoir with an opening (90), and a dispenser member mounted on the opening of the reservoir;

the fluid dispenser member comprising:

- a body (1) inwardly defining a chamber (15) of variable volume, said body defining a bottom end (10);

- an actuator rod (7) that can be reciprocated axially in said body, thereby causing the volume in said chamber to vary, said rod comprising a bottom portion engaged in the body, and a top portion defining a top end (79);

- a peripheral bearing collar (52) extending radially outwards, said collar including a bottom face (51) designed to come into abutment, at least indirectly, against an edge (911) of the opening (90) of the fluid reservoir; and

wherein the axial height HS1 between the bottom face of the collar and the top end of the actuator rod is substantially equal to the axial height HIl between the bottom face of the collar and the bottom end of the body; and

wherein HS1 and HI1 are all about 7 mm to 9 mm; and

wherein the reservoir (9) includes a substantially cylindrical projecting neck (91) defining the opening (90), said neck defining a free top end forming an annular edge (911) on which the

collar (52), and a bottom end connected to the reservoir body, the bottom end (10) of the body being situated in the neck; and

wherein the axial height HC of the neck is about 7 mm to 9 mm for an inside diameter of about 8 mm and an outside diameter of about 13 mm.

2. A fluid dispenser comprising both a fluid reservoir defining a reservoir with an opening (90), and a dispenser member mounted on the opening of the reservoir;
the fluid dispenser member comprising:

- a body (1) inwardly defining a chamber (15) of variable volume, said body defining a bottom end (10);

- an actuator rod (7) that can be reciprocated axially in said body, thereby causing the volume in said chamber to vary, said rod comprising a bottom portion engaged in the body, and a top portion defining a top end (79);

- a peripheral bearing collar (52) extending radially outwards, said collar including a bottom face (51); and

- a neck gasket (2) including a top face (21) and a bottom face (22), the top face (21) being in contact with the bottom face (51) of the collar (52), and the bottom face (22) being designed to come into contact with an edge (911) of the opening (90) of the reservoir (9),

wherein the axial height HS2 between the bottom face of the gasket and the top end of the actuator rod is substantially equal to the axial height HI2 between the bottom face of the gasket and the bottom end of the body; and

wherein HS2 and HI2 are all about 7 mm to 9 mm; and

wherein the reservoir (9) includes a substantially cylindrical projecting neck (91) defining the opening (90), said neck defining a free top end forming an annular edge (911) on which the gasket (2) rests, and a bottom end connected to the reservoir body, the bottom end (10) of the body being situated in the neck; and

wherein the axial height HC of the neck is about 7 mm to 9 mm for an inside diameter of about 8 mm and an outside diameter of about 13 mm.

3. (canceled).

4. A dispenser according to claim 1, further comprising a dispenser head (8) mounted on the top portion of the rod (7) and forming a dispenser orifice (81), said head defining a top end (83), the axial height HS3 between the bottom face of the collar and the top end of the head is slightly greater than the axial height HI2 between the bottom face of the collar and the bottom end of the body.

5. A dispenser according to claim 4, in which HS3 is about 9 mm to 10 mm.

6. A dispenser according to claim 1, in which the gasket presents a thickness of about 0.5 mm to 1 mm.

7. A dispenser according to claim 1, presenting an axial height HT of about 16 mm to 17 mm, excluding the head.

8. A dispenser according to claim 1, presenting a total axial height HT of about 17 mm to 19 mm.

9. A dispenser according to claim 1, further comprising:

- a covering hoop (4) designed to extend around the body (1) outside the edge of the opening, said hoop including a top end (41); and

- a dispenser head (8) mounted on the top portion of the rod and defining a lateral dispensing orifice (81), the head being axially displaceable inside the top end of the hoop.

10. A dispenser according to claim 9, in which the hoop is mounted on a fixing ring (3) that is engaged with the body (1) and with the reservoir (9).

Claims 11-13: (canceled).

14. The dispenser according to claim 1, further comprising a neck gasket disposed in contact with the bottom face of the collar so as to be compressed between the collar and the edge of the opening.

15. The dispenser according to claim 2, further comprising a dispenser head (8) mounted on the top portion of the rod (7) and forming a dispenser orifice (81), said head defining a top end (83), the axial height HS3 between the bottom face of the collar and the top end of the head is slightly greater than the axial height HI2 between the bottom face of the collar and the bottom end of the body.

16. The dispenser according to claim 15, in which HS3 is about 9 mm to 10 mm.

17. The dispenser according to claim 2, in which the gasket presents a thickness of about 0.5 mm to 1 mm.

18. A dispenser according to claim 2, presenting an axial height HT of about 16 mm to 17 mm, excluding the head.

19. The dispenser according to claim 2, presenting a total axial height HT of about 17 mm to 19 mm.

20. The dispenser according to claim 2, further comprising:

- a covering hoop (4) designed to extend around the body (1) outside the edge of the opening, said hoop including a top end (41); and

- a dispenser head (8) mounted on the top portion of the rod and defining a lateral dispensing orifice (81), the head being axially displaceable inside the top end of the hoop.

21. The dispenser according to claim 20, in which the hoop is mounted on a fixing ring (3) that is engaged with the body (1) and with the reservoir (9).

22. The dispenser according to claim 1, further comprising a piston sliding in a top section disposed entirely outside the neck of the reservoir, so that said section can have an inside diameter that is sized independent of the neck.

23. The dispenser according to claim 2, further comprising a piston sliding in a top section disposed entirely outside the neck of the reservoir, so that said section can have an inside diameter that is sized independent of the neck.

EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

None.

RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

None.

APPENDIX - ANNOTATED FIGURE 1 FROM KNICKERBOCKER (US 4,252,507)

This annotated Figure 1 from Knickerbocker was submitted on December 10, 2008.